

REMARKS

The May 10, 2007 Office Action regarding the above-identified application has been carefully considered; and the claim amendments above together with the remarks that follow are presented in a bona fide effort to respond thereto and address all issues raised in that Action.

The original claims have been replaced with new claims 44-57 to distinguish over art applied in the Action. Care has been taken to avoid entry of new matter. For example, new claim 44 is based on original claims 22, 23 and some further dependent claims off of 23. Claim 44 also recites that the auxiliary item is one "not printed from a print file from the soft copy" part of the document. It is believed that this added recitation is supported by paragraph 0013 of the original specification, which gives credit cards as an example of not-printed materials, although those skilled in the art will recognize that other types of auxiliary materials may be involved such as offset printed materials produced by separate procedures. New independent product claim 52 is similar in style to claim 36 but incorporates aspects of the software similar to aspects of the method of claim 44, whereas new system claim 56 is based in part on claim 41 and incorporates aspects of the similar to aspects of the method of claim 44. Hence, the product and system claims should be similarly supported by the original written description.

For reasons discussed below, it is believed that this case is in condition for allowance. Prompt favorable reconsideration of this amended application is requested.

Product claims 36-40 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter, on the grounds that they recited a program product per se, which was deemed to be an abstract idea. The new product claims 52-55 have been drafted to avoid this ground of rejection by positively reciting a product comprising a storage medium and programming embodied in the medium. Withdrawal of the rejection is respectfully requested.

The Office Action included three art rejections under 35 U.S.C. § 103 on the ground that the original claims lacked patentability. The first rejection asserted that claims 1-3, 5, 6, 9-11, 14, 15, 18-24, 26-30, 36 and 40-43 were obvious over US patent no. 6,650,431 to Roberts et al. (hereinafter Roberts). Claims 4, 16, 17, 25 and 31-33 were rejected as obvious over Roberts in view of US patent no. 6,873,426 to Farrell. Claims 7, 8, 12, 13, 34, 35 and 37-39 were rejected as obvious over Roberts in view of US patent no. 7,034,951 to Jones et al. (hereinafter Jones). New claims 44-57 have been drafted to distinguish over the various combinations proposed in the art rejections, therefore Applicants submit that the new claims are patentable over the applied art and that these three rejections should be withdrawn.

Claim 44 includes steps of:

- scanning one or more sheets of the collated hard copy portion of the document to detect an identifier on the collated hard copy portion of the document;

- adding an auxiliary item, not printed from a print file from the soft copy, to the collated hard copy portion of the document to form the final document;

- scanning the auxiliary item to detect an identifier on the auxiliary item;
- and

- verifying completion of the final document in accordance with the document attributes, based at least in part on the detected identifiers.

It is respectfully submitted that the applied art does not suggest adding an auxiliary item to the collated hard copy portion of the document to form the final document, where that auxiliary item is one not printed from a print file from the soft copy, in combination with verifying completion of the final document in accordance with the document attributes, based at least in part on detected identifiers from the collated document and the auxiliary item.

Roberts discloses a technique for selective routing of portions of an electronic document to different output devices. In Roberts, the electronic document comprises first and second sets

of pages having different characteristics. Roberts identifies the pages of the different sets and selectively routes the pages to compatible output devices, e.g. different types of printers. Attention may be directed, for example, to the abstract of the Roberts patent.

The Examiner takes the position that Roberts does not suggest the auxiliary feed recited in several original dependent claims. It therefore appears that Roberts would not suggest adding an auxiliary item, not printed from a print file from the soft copy, to the collated hard copy portion of the document to form the final document, as now recited in claim 44. The Office Action, in the second rejection, relied instead on Farrell for an alleged teaching to add an auxiliary item. Farrell discloses a printing technique that alternately provides “literal finishing and abstract finishing to a print job” (see abstract). Literal finishing apparently refers to the finishing capabilities existing on the print machine available at the time of printing. By contrast, abstract finishing refers to other finishing operations to be performed later (column 4, lines 49-55). The later abstract finishing may be performed by the same finishing equipment (column 4, lines 34-42), although the later abstract finishing apparently would be done off-line (“off equipment”) or by separate equipment (column 4, lines 20-24). Abstract finishing operations include insertion of slipsheets and/or marking separators (abstract), although those ‘abstract’ operations are to be performed later. In Farrell, the selection of literal finishing by the print machine or later ‘abstract’ finishing is based on compatibility of the desired finishing with the finishing element available to process the printer job or on a user selection (abstract; and column 5, lines 40-49). The abstract finishing, such as insertion, is not done as part of the processing associated with the basic document printing and collation but by some later separate processing operation and there appears to be no verification of completion after the later abstract finishing.

The rejections rely on Roberts for an alleged disclosure of scanning to capture an identifier and associated verification of collation, citing items 710 and 712 of FIG. 7 and the description in column 18, lines 27-67). Items 710 and 712, however, appear to be reader devices on the input side of the merge process used to control merge or collation processing, and as such, those readers do not scan “one or more sheets of the collated hard copy portion of the document” (emphasis added), as recited in the claim. Since the readers scan pages prior to collation, the readers do not provide identifiers from the collated document for use in verifying completion of the document. Farrell is not cited for scanning to detect an identifier. Since Roberts only scans the printed pages before the merge, the combination of Roberts and Farrell would also fail to teach scanning of the auxiliary item, as now recited in the independent method claim.

For the reasons outlined above, it is believed that the combination of Roberts and Farrell would not satisfy the claim requirements for adding an auxiliary item, not printed from a print file from the soft copy, to the collated hard copy portion of the document to form the final document; scanning one or more sheets of the collated hard copy portion of the document to detect an identifier as well as the auxiliary item to detect an identifier on the auxiliary item; and then verifying completion of the final document in accordance with the document attributes, based at least in part on the detected identifiers. Hence, neither Roberts alone nor Roberts in combination with Farrell would actually satisfy new method claim 44.

The Action cited the additional document to Jones only for a teaching of reprinting a portion of the document. Addition of a reprint step to Roberts (or to the combination of Roberts and Farrell) would not result in a combination that satisfies the above-discussed requirements of claim 44. Claim 44 and the claims that dependent from it therefore should be patentable over

any and all of the combinations proposed in the Office Actions. The three art rejections therefore should be withdrawn with regard to claims 44-51.

Product claim 52 and control system claim 56 both include recitations of:

obtaining an identifier on the collated hard copy portion of the document based on a scanning of one or more sheets of the collated hard copy portion of the document;

obtaining an identifier on the auxiliary item based on a scanning the auxiliary item; and

verifying completion of the final document in accordance with the document attributes, based at least in part on the identifiers.

It is respectfully submitted that none of the proposed combinations of art would satisfy these claim requirements. The rejections rely on Farrell for disclosure of the readers 710 and 712. As discussed above, however, those devices of Farrell only read information from printed pages before the merging. As a result, in any combination based on such a disclosure by Farrell, there is no teaching of (1) obtaining an identifier on the collated hard copy portion of the document based on a scanning ... of the collated hard copy portion of the document; (2) obtaining an identifier on the auxiliary item based on a scanning the auxiliary item; and (3) verifying completion of the final document...based at least in part on the identifiers. Hence, neither Roberts, Roberts in combination with Farrell, nor Roberts in combination with Jones actually meets all requirements of either independent claim 52 or independent claim 56. Claims 52-57 therefore patentably distinguish over the art applied in the various rejections set forth in the Office Action.

Upon entry of the above claim amendments, new claims 44-57 are active in this application, all of which should be directed to patentable subject matter as well as unobvious over the art applied in the Action. Applicants therefore submit that all of the claims are in

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condition for allowance. Accordingly, this case should now be ready to pass to issue; and Applicants respectfully request a prompt favorable reconsideration of this matter.

It is believed that this response addresses all issues raised in the May 10, 2007 Office Action. However, if any further issue should arise that may be addressed in an interview or by an Examiner's amendment, it is requested that the Examiner telephone Applicants' representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Keith E. George
Registration No. 34,111

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 KEG:apr
Facsimile: 202.756.8087
Date: October 2, 2007

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